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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,174	06/05/2008	David Macher	40149/01801	4087
30636	7590	03/24/2011	EXAMINER	
FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				MOHANDESI, JILA M
3728		ART UNIT		PAPER NUMBER
03/24/2011		MAIL DATE DELIVERY MODE		
		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,174	MACHER ET AL.	
	Examiner	Art Unit	
	JILA M. MOHANDESI	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 June 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7,9 and 13 is/are rejected.
 7) Claim(s) 8,10-12 and 14 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 02 August 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/05/2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Baggio et al. (US 4,910,881). Baggio et al. discloses an electrically heatable insole (see figure 3), comprising: at least one sole basic body (6); a cover layer (3); at least one heating electrode (electric resistor 5); at least one rechargeable battery (accumulators 10) electrically connected to the heating electrode; and a control circuit (conductors 11) controlling a heating process and recharging the battery, wherein the heating electrode, the battery and the control circuit are disposed between the sole basic body and the cover layer, and wherein the control circuit includes a remote control device (control unit 16 with switch 17 and luminous indicator 18) switching the heating process on and off; wherein the battery is disposed in a heel region; wherein the control circuit continuously regulates a strength of the heating process; wherein the remote control device has an external operating part and an incorporated control part (16, 17 & 18); wherein the operating part includes display elements for at least one of (i) a functional display and (ii) a temperature display.

3. Claims 1, 3, 5-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaccae et al. (US 4,507,877). Vaccae et al. discloses an electrically heatable insole

(see figure 1), comprising: at least one sole basic body (4); a cover layer (40); at least one heating electrode (electric resistance heater heating 1); at least one rechargeable battery (rechargeable batteries 2) electrically connected to the heating electrode; and a control circuit (voltage limiter 5, see figure 4) controlling a heating process and recharging the battery, wherein the heating electrode, the battery and the control circuit are disposed between the sole basic body and the cover layer, and wherein the control circuit includes a remote control device (recharging socket and control switch 31) switching the heating process on and off; wherein the battery is disposed in a heel region; wherein the control circuit continuously regulates a strength of the heating process; wherein the remote control device has an external operating part and an incorporated control part; wherein the operating part includes display elements for at least one of (i) a functional display and (ii) a temperature display.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Baggio et al. or Vaccae et al. in view of Ford et al. (Pub. No. US 2004/0164066). Each of Baggio et al. or Vaccae et al. as described above discloses all the limitations of the claims except for the rechargeable battery being lithium batteries. Ford et al. discloses that it is desirable to use lithium batteries for thermal garments. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use lithium batteries for the rechargeable batteries of Baggio et al. or Vaccae et al. as art recognized equivalents which will perform equally as well.
7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Baggio et al. or Vaccae et al. in view of Nikolaus (US 2004/0237643). Each of Baggio et al. or Vaccae et al. as described above discloses all the limitations of the claims except for the resistors to being Minimelf resistors. Nikolaus discloses that Minimelf resistors are a standard resistor that has good stability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Minimelf resistors for the resistors of Baggio et al. or Vaccae et al. as art recognized equivalents which will perform equally as well.
8. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Baggio et al. or Vaccae et al. in view of Cioletti et al. (US 5,667,290). Each of Baggio et al. or Vaccae et al. as described above discloses all the limitations of the claims except for the remote control device having a contact-free switch. Cioletti et al. discloses using a contact-free switch where the switch can be configured as a reed

switch and a magnetic switch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use reed and magnetic contact-free switch for the switch of Baggio et al. or Vaccae et al. as art recognized equivalents which will perform equally as well.

Allowable Subject Matter

9. Claims 8, 10-12 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are insoles analogous to applicant's instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
03/22/2011